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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,937	01/24/2005	Gregory Alan Steube	S-8494 (1502-88 PCT US)	2176

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MELVILLE, NY 11704

EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

MAIL DATE	DELIVERY MODE
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09/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/521,937

**Applicant(s)**

STEUBE, GREGORY ALAN

**Examiner**

/Susan W. Berman/

**Art Unit**

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13 and 15-19 is/are allowed.
- 6) ☒ Claim(s) 1-7, 14 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

***Response to Amendment***

The objection to the disclosure because of the stated informalities is withdrawn because applicant has amended the specification to state that the polydimethylsiloxanes are polymers of the recited materials. Applicant could obtain polydimethylsilicones by copolymerizing silicon chloride with one of the other listed silanes.

The objection to claims 5, 13 and 19 because of informalities is withdrawn.

Some of the rejections of claims 1-22 under 35 U.S.C. 112, second paragraph, are overcome by the amendments to the claims. Applicant has clarified that the radiation curable silicone is a silicone having pendant epoxy groups and that the "secondary silicone component" differs from the "silicone-epoxy copolymer".

The rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Leir et al (5,576,356) in view of Shepard et al (5,260,348) is withdrawn. Shepard et al teach that silane isocyanurates are adhesion promoters, however, no motivation is found to add adhesion promoters to the compositions disclosed by Leir et al.

***Response to Arguments***

Applicant's arguments filed 7-12-2007 have been fully considered but they are not persuasive with respect to the rejections of record under 35 USC 103(a) as being unpatentable over Leir et al (5,576,356) in view of Bilodeau (6,486,267). The rejection has been rewritten to clarify that the curable organopolysiloxane "B" taught by Bilodeau et al can be an epoxy-functional organopolysiloxane and that component "A" can be a different siloxane of formula "A-2" in response to applicant's request for reconsideration.

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The rejection of claims 1-5 and 7 under 35 U.S.C. 102(b) as being anticipated by Leir et al (5,576,356) is withdrawn. It is agreed, as argued by applicant, that Examples 31-32 of Leir et al do not contain an epoxy silicone even though the term epoxysilicone is found in column 13, line 47. Examples 31-32 contain a mercapto functional silicone, CHVE and cationic photoinitiator. Example 33 contains an epoxysilicone, CHVE and a cationic photoinitiator (column 14, lines 5-14). Leir et al do not disclose a mixture of epoxy functional silicone and a different silicone.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leir et al (5,576,356) in view of Shepard et al (5,260,348).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7, 14, 20, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 1 for the recitation “lubricant according to claim 1” in claims 2-7 because claim 1 recites a “curable composition”. In claims 6, 14, 20, 21 and 22, does applicant intend to set forth “poly(vinyl trimethoxy silane), poly[bis(trimethoxysilyl)propyl amine], poly(gamma-ureidopropyl trimethoxy silane)... a poly(fluorosilicone)”? What compound or structure is intended by the recitation “organosilane ester tri(3-(trimethoxysilyl)propyl)isocyanurate”? Does applicant mean an “ester of tri(3-(trimethoxysilyl)propyl)isocyanurate”? In claim 7, does applicant intend to set “composition

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according to claim 1 curable by..." or does applicant intend to set forth a "lubricant that is a cured product obtained by curing the composition according to claim 1 by exposure to at least one of ultraviolet light..."?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leir et al (5,576,356) in view of Bilodeau (6,486,267). Leir et al disclose cationically co-curable polysiloxane release compositions comprising an epoxy-functional polysiloxane (a) and a co-reactive monomer (b) with a cationic photocatalyst. Vinyl ether reactive diluents, including species in instant claim 3, are taught in column 7, lines 25-27 and column 11. Iodonium salts, including species in instant claim 5, are taught in column 7, lines 60-66. Coating and radiation curing is taught in column 8, lines 50-64. Examples 31 and 32 teach mixtures of mercapto-functional silicone, a vinyl ether and iodonium salt. Example 33 teaches mixtures of epoxy silicone with a vinyl ether and an iodonium salt. Leir et al teach that the compositions provide release coatings so they would be expected to provide a lubricant for medical devices. Leir et al do not teach adding a different silicone component in combination with an epoxy functional silicone.

Bilodeau teaches release compositions wherein the compound (A) can be silicone of formula A-2 and B can be a radiation-curable epoxy organopolysiloxane. See the Abstract and column 6, line 57, to column 8, line 7.

It would have been obvious to one skilled in the art at the time of the invention to substitute the mixture of a polysiloxane of formula A-2 and a radiation curable epoxy organopolysiloxane taught by Bilodeau for the siloxane having epoxy functionality in the analogous radiation curable compositions disclosed by Leir et al. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing useful coating compositions having release properties, as taught by Leir et al and by Bilodeau, in the absence of evidence to the contrary.

***Allowable Subject Matter***

Claims 8-13 and 15-19 are allowed.

Claims 14 and 21-22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:  
The prior art known to the examiner teaches that polydimethylsiloxane is a well-known silicone lubricant for coating hypodermic needles. Epoxysilicones are not mentioned as components of the coating compositions disclosed. The examiner has not noted any motivation to substitute an epoxy silicone for the disclosed polydimethylsilicones.

The following references are cited as art of interest: Williamitis et al (4,664,657) disclose a lubricant for catheter assemblies comprising a film of polydimethylsilicone. Pelkey (5,911,711) discloses a lubricant system for hypodermic needles comprising a partially cured organosilicone and a polydimethylsiloxane. Spielvogel et al (4,720,521), already of record, disclose silicone compositions having lubricating properties for coating hypodermic needles. Three reactive silicones comprising vinyl-functionality and hydrogen functionality form a crosslinked matrix for a non-reactive silicone that provides lubricity.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Susan W. Berman/ whose telephone number is 571 272 1067.

The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SB  
9/21/2007

/Susan W Berman/  
Primary Examiner  
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